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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

KUCAB, JAMIE R

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/649,042	Applicant(s) CHATANI, MASAYUKI	
	Examiner JAMIE KUCAB	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-13, 15-17 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-13, 15-17, and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination ("RCE") under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 19, 2009 has been entered.

Acknowledgements

2. In accordance with the RCE above, claims 1-6, 8-13, 15-17, and 24 are currently pending.
3. Claims 1-6, 8-13, 15-17, and 24 are examined below.
4. This Office action is given Paper No. 20090925 for reference purposes only.
5. Based on a comparison of the PGPub US 2005/0050208 A1 with Applicant's originally submitted specification, the PGPub appears to be a fair and accurate record of the Applicant's specification. Therefore, except where otherwise noted, references in this action to Applicant's specification refer to paragraph numbers in the PGPub.

Claim Rejections - 35 USC § 112, 1st Paragraph

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-6, 8-13, 15-17, and 24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The limitation “wherein the client device obtains the digital authentication ticket via a communication network, the client device being capable of obtaining the digital authentication ticket anywhere the client device has access to the communication network” was not previously disclosed.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-6, 8-13, 15, 16, and 24 are rejected under 35 U.S.C. §102(e) as being anticipated by Ohmori et al. (US Patent No. 7,020,636, hereafter, "Ohmori").

10. Regarding claims 1, 9, 15, 16, and 24, Ohmori discloses method/system for controlling access to computer readable content, comprising the operations of:

- a. receiving a digital authentication ticket (step S208, Fig. 14), obtained by a client device ("IC CARD 20," Fig. 1) and saved in memory of the client device, before being transmitted to a computer system ("DVD PLAYER 40," Fig. 1) having particular computer readable content ("ENCRYPTED CONTENT FROM DVD"), wherein the digital authentication ticket includes a digital code ("title key"), the digital code being separate from the particular computer readable content to enable receipt of the digital authentication ticket independent of a location of the particular computer readable content;
- b. transferring (step S174, Fig. 10) the digital authentication ticket wirelessly (C27 L22-25) from the client device to the computer system;
- c. determining, at the computer system, whether the digital authentication ticket corresponds to the particular computer readable content when the digital authentication is obtained ("DECRYPT ENCRYPTED CONTENT USING TITLE KEY," step S164, Fig. 10);
- d. allowing access to the particular computer readable content at the computer system when the digital authentication ticket corresponds to the particular computer readable content ("REPRODUCE AND OUTPUT CONTENT," step S165, Fig. 10);

- e. preventing access to the particular computer readable content at the computer system when the digital authentication ticket does not correspond to the particular computer readable content (inherently, because the content is encrypted, therefore, if the title key does not correspond to the encrypted content, the result of the decryption step would not be unencrypted content but rather unintelligible garbage);
 - f. invalidating the digital code after allowing access to the particular media to prevent unlocking of additional media content without purchase (“...judge whether the digital work is allowed to be used when the elapsed date and time is on or after the present date and time,” C4 L7-39; or, alternately, “the number of times reproduction is allowed can be set,” C4 L40-56); and
 - g. wherein the client device obtains the digital authentication ticket via a communication network (“COMMUNICATION LINE 60,” Fig. 11), the client device being capable of obtaining the digital authentication ticket anywhere the client device has access to the communication network (at the SHOP APPARATUS 10).
11. As to claim 2, Ohmori further discloses the operation of transmitting the digital authentication ticket to the client device in response to receiving a request for the digital authentication ticket (step S122, Fig. 13).
12. As to claims 3 and 10, Ohmori further discloses the operation of processing the request for the digital authentication ticket, wherein the processing includes charging a fee to a user (“the rental agent receives a user’s payment for the rental,” C2 L57-58).

13. As to claims 4 and 11, Ohmori further discloses wherein the request is received using a payment server ("SHOP APPARATUS 10," Fig. 1) located remotely from the client device (see Fig. 1).

14. Regarding claims 5 and 12, Ohmori further discloses the operation of transmitting the digital authentication ticket from a game server ("SERVER APPARATUS") to the payment server (step S207, Fig. 14), the game server storing a plurality of digital authentication tickets (inherently, because DVD rental stores do not stock just a single title).

15. As to claims 6 and 13, Ohmori further discloses wherein the computer system is located locally to the client device (see Fig. 1).

16. Regarding claim 8, Ohmori further discloses wherein the digital authentication ticket is transmitted wirelessly from the payment server to the client device (C27 L22-25).

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 1-6, 8-13, 15, 16, and 24 are alternatively rejected under 35 U.S.C.

§103(a) as being unpatentable over Ohmori.¹

19. As detailed in the above 102 rejection above, it is the Examiner's principle position that Ohmori anticipates a plurality of digital authentication tickets and preventing access because of the inherencies noted above.

20. If not inherent, then Ohmori discloses the claimed invention as detailed above, except Ohmori does not explicitly disclose a plurality of digital authentication tickets and preventing access when the code does not correspond to the content. Therefore if not inherent, it would have been obvious to a person having ordinary skill in the art at the time of the invention to include a plurality of digital authentication tickets and preventing access when the code does not correspond to the content, because this would achieve the predictable results of making the businesses profitable by diversifying the offering of DVD titles and preventing illicit copying of those titles.

21. Claim 17 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ohmori in view of Ginter et al. (US Pat. No. 5,892,900 hereafter "Ginter").

22. Regarding claim 17, Ohmori discloses all the elements of the claimed invention as detailed above, but Ohmori fails to explicitly disclose wherein the game server transmits the computer readable content to the computer system.

¹ See MPEP §2112 III expressly authorizing alternative §102/103 rejections when the question of inherency is present in the anticipation rejection.

23. However, Ginter teaches wherein the game server ("CONTENT CREATOR 102") transmits the computer readable content to the computer system ("CONTENT USER 112," Fig. 2A).

24. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the method/system of Ohmori to include the transmitting from game server to computer system of Ginter in order to achieve the predictable result of streamlining delivery of content and reducing the inventory burden on the owner of the payment server.

Claim Interpretation

25. Independent claims (1, 9, and 24) are examined together, since they are not patentably distinct. If Applicant expressly states on the record that two or more independent and distinct inventions are claimed in this application, the Examiner may require the applicant to elect an invention to which the claims will be restricted.

Response to Arguments

26. Applicant's arguments with respect to the §102 and §103 rejections of the claims have been fully considered, but they are not persuasive. See the above rejections for a detailed mapping of the previously applied prior art to the newly added limitation.

Conclusion

27. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jamie Kucab whose telephone number is 571-270-3025. The Examiner can normally be reached on Monday-Friday 9:30am-6:00pm EST.

28. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

29. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JK

/ANDREW J. FISCHER/
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